

REMARKS

The Examiner has rejected Claims 1-3, 5, 8-15, 17-18, 20 and 24 under 35 U.S.C. 102(b) as being anticipated by Ralston et al (U.S. Patent No. 6,842,773). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied on step 708 in Figure 7A of Ralston to make a prior art showing of applicant's claimed "removing non-static data including visible end-of-line characters and headers, from the electronic mail message" (see the same or similar, but not necessarily identical language in each of the independent claims).

Applicant respectfully asserts that item 708 specifically shows "strip[ping] headers and hidden information to leave visible text body of message." Clearly, removing hidden information, as taught in Ralston, does not meet, and actually even *teaches away* from, applicant's claimed "removing non-static data including visible end-of-line characters" (emphasis added).

Still with respect to each of the independent claims, the Examiner has relied on Col. 14, lines 10-20 and Col. 13, lines 7-14 in Ralston to make a prior art showing of applicant's claimed technique "wherein the non-static data is removed to prevent the non-static data from being subject to the checksum, so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message." Applicant respectfully asserts that such excerpt only teaches removing headers or hidden information which "could potentially confuse processing of the message." However, as argued above, Ralston does not teach removing non-static data in the manner claimed by applicant, and especially not "so that non-static data forged by spammers does not compromise the identification of the electronic message as the unsolicited message," as specifically claimed by applicant (emphasis added).

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The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Ralston reference, as noted above. A notice of allowance or a specific prior art showing of each of the foregoing claimed features, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. Just by way of example, with respect to Claim 3 et al., the Examiner has relied on Figures 7A-7D in Ralston to make a prior art showing of applicant's claimed technique "wherein the portions comprise lines of data." Applicant respectfully asserts that Figures 7A and 7B merely relate to forming a fingerprint for each word, whereas Figures 7C and 7D relate to forming a fingerprint for groups of characters. Simply nowhere in Ralston is there any disclosure of individual checksums for portions of data, where such portions include lines of data, in the context claimed by applicant.

With respect to Claim 4 et al., as rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston, the Examiner has again argued that "it is notoriously well known in the art to make comparisons between items in any order [and that t]herefore it would have been obvious to one of ordinary skill in the art at the time of the invention to compare checksums in either direction (top to bottom, or bottom to top) providing the benefit of identifying unsolicited emails."

Further, the Examiner has responded to applicant's arguments that simply because it is allegedly well known to make comparisons between items in any order, as the Examiner contends, such does not make applicant's specific claim language obvious. In

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particular, the Examiner has argued that applicant's claim language is confusing as to the motivation for "comparing a checksum comprises comparing checksums starting with one of the portions at the end of the remaining data and working backwards through the data" (see Claim 4 et al.). The Examiner has argued that such claim language seems moot in light of the prior removal of non-static material when read in view of the specification (Page 11, lines 14-19).

Applicant respectfully disagrees with this assertion. Simply because it is allegedly well known to make comparisons between items in any order, as the Examiner contends, such does not make applicant's specific claim language obvious. Applicant does not merely claim comparing items in any order, but claims, in the relevant claim(s), comparing checksums for each portion of remaining data starting at the end of the remaining data and working backwards through the data. Thus, each portion of remaining data has an associated checksum which is compared starting at the end of the remaining data, working through to the beginning of the remaining data. Thus, such feature would not be obvious in view of the claimed context of such comparing and in view of the advantages thereof, namely in order to reduce required processing.

With respect to Claim 5 et al., the Examiner has relied on Figures 5A-5F in Ralston to make a prior art showing of applicant's claimed "deleting the electronic mail message if the message is identified as an unsolicited message." Applicant respectfully asserts that such Figures only disclose "Move to Bulk Mail Folder" when the e-mail is determined to be suspect. Clearly, moving an e-mail to a folder does not meet "deleting the electronic mail message," as specifically claimed by applicant (emphasis added).

With respect to Claims 11 and 12 et al., the Examiner has simply stated that Ralston teaches that "[a]ny message unique to the mail system has its fingerprint stored in the message database (206) to allow for matching to subsequent messages." However, the Examiner has failed to note any specific excerpt from Ralston that teaches such claim language. Applicant notes that Ralston only teaches that "[i]f there is no match, the fingerprint for the message is added to the store(s) in step 682" (emphasis added).

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Applicant further notes that such store is only utilized “[t]o determine if the e-mail message 400 has been sent a number of times over a given time period” (see Ralston, Col. 9, line 65-Col. 10, line 10). Thus, simply nowhere in Ralston is there any disclosure of “updating the database with new checksums” (Claim 11 et al.) where “the database is updated based on checksums generated from electronic messages received and identified as an unsolicited message” (Claim 12 et al.-emphasis added).

With respect to Claim 24, the Examiner has simply relied on the rejections made with respect to Claim 1 et al. to make a prior art showing of applicant’s claimed technique “wherein the non-static data is removed prior to the checksum being generated.” For substantially the same reasons as argued above with respect to each of the independent claims, applicant respectfully assert that Ralston’s hidden information does not meet applicant’s claimed “non-static data.”

With respect to the 102 rejection, applicant again respectfully asserts that the Ralston reference fails to meet all of applicant’s claim limitations, as noted above.

With respect to the 103 rejection, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

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Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P315/01.180.01).

Respectfully submitted,
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